

II. REMARKS

Claims 1-23 are in the application. Claims 1, 13, and 21 are in independent form.

Election/Restriction Requirement

The Examiner has required Applicants to restrict prosecution to one invention. According to the Examiner, the instant Application contains claims to three distinct inventions. Applicants disagree with the requirement for restriction and hereby request reconsideration and withdrawal or modification of the requirement for the reasons discussed in greater detail below. In accordance with 37 C.F.R. 1.143, Applicants hereby make a provisional election with traverse to prosecute the invention of group I (claims 1-11 and 13-19) in the event the restriction requirement becomes final.

Inventions I and II

The Examiner states that Invention I (claims 1-11 and 13-19) and Invention II (claims 12 and 20) "are related as process and apparatus for its practice." Further, the Examiner states that Inventions I and II are distinct because "the process as claimed can be practiced by another apparatus such as manually controlling etching."

Applicants submit that even if Invention I and Invention II are distinct, the inventions are clearly closely related and an examination of both inventions would not create a serious burden on the Examiner. (See MPEP § 803.) Claim 12 recites "[a] computer readable media comprising computer instructions for carrying out the steps of claim 1." Because the apparatus of claim 12 is only drawn to media comprising instructions for carrying out the method of claim 1, the field of search should be the same.

The same would be true for claims 14-19 and claim 20 (claim 13 is cancelled by this Response). Applicants therefore request that the restriction requirement for Inventions I and II be withdrawn.

Inventions I and III

The Examiner also states that Invention I (claims 1-11 and 13-19) and Invention III (claims 21-23) "are related as apparatus and product made." Further, the Examiner states that

Inventions I and III are distinct because "[i]n this case the apparatus can be used for etching a hole and not for repairing a defect." Applicants have amended independent claim 21 to clarify that the apparatus includes a means for repairing a defect. Accordingly, Applicants request that the restriction requirement for Inventions I and III be withdrawn.

Inventions II and III

Finally, the Examiner states that Invention II (claims 12 and 20) and Invention III (claims 21-23) "are related as combination and subcombination." Further, the Examiner states that Inventions II and III are distinct because "the apparatus for ion milling does not require a computer readable medium."

As is the case above, Applicants submit that the inventions are clearly related and no serious burden on the examiner would result from examining these inventions together. Accordingly, Applicants request that the restriction requirement for Inventions II and III be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 1-11

The Examiner objects to claims 10 and 11 under 35 U.S.C. § 112 as indefinite. Applicants have submitted an amendment to claim 1 to address the Examiner's objection.

Rejections under 35 U.S.C. § 102

Claim 13

Claim 13 stands rejected as anticipated by Nakagawa et al. (U.S. Pat. No. 4,874,460). Applicants have cancelled claim 13, and have rewritten amended claim 14 in independent form. Claims 16, 17, 19, and 20 have been amended so as to be dependent on amended claim 14.

Rejections under 35 U.S.C. § 103**Claims 13 and 16-19**

Claims 13 and 16-19 stand rejected as unpatentable over Nakagawa in view of Casey, Jr. et al. (U.S. Pat. No. 6,042,738). Claim 13 has been cancelled. Claims 16-19 have been amended to be dependent on amended claim 14.

Further, 35 USC § 103(c) states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

At the time the invention of the present application was made, the subject matter of U.S. Pat. No. 6,042,738 and the claimed invention were both owned by or subject to an obligation of assignment to FEI Company. Accordingly, Applicants request that the Examiner's 103 objections to claims 16-19 be withdrawn.

Double Patenting Objections

Claims 1-11 and 13-19 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Pat. No. 6,322,672 in view of Casey. Once the claims in this case have been indicated as otherwise allowable, Applicants will execute and file an appropriate terminal disclaimer in compliance with 37 C.F.R. 1.321.

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III. CONCLUSION

Applicants submit that the application is now in condition for allowance and respectfully request allowance of the case.

Respectfully submitted,



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